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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/246,409	02/08/1999	SHMUEL SHAFFER	99-P-7454-US	6137

7590 03/25/2005

SIEMENS CORPORATION
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EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/246,409

Applicant(s)

SHAFFER ET AL.

Examiner

Ming Chow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because corrections made to items 306a and 306b of Fig. 3A cause confusions. It is unclear the corrections made to items 306a and 306b indicating the two items are deleted or the corrections are new drawings for the two items. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply, if any, to the Office action which is made final.

2. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Applicant is required to submit the proposed drawing and marked-up copy in reply, if any, to the Office action which is made final.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “said message” (line 8 and line 9) is not clearly defined. It is unclear the claimed “said message” refers to “one or more messages” (line 2), or “a message” (line 7), or “a threaded message” (line 4), or “another message” (line 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy (US: 6330589), in view of Bailey et al (US: 5835084).

Kennedy teaches on item 38 Fig. 3 “local message store” (claimed “memory”). Kennedy teaches on Fig. 4a and 4b messages are threaded with other one or more messages. Kennedy also teaches on column 3 line 47-50 the reply message (claimed “threaded message”; see line 4-5 page 8 of the specifications for definition of “thread messages” by Applicant) includes a message identifier for a root message (claimed “includes at least a portion of another message”). Kennedy further teaches on column 3 line 53-58 and Fig. 5 the root message (claimed “another message”) and reply message are grouped (to be a threaded message). Kennedy also teaches on item 36 Fig. 3 email program module (claimed “controller”; including item 37 Fig 3 message manager program module). Kennedy teaches on column 2 line 63-64 nested replies are presented (claimed “accessing”) sequentially. Kennedy teaches on Fig. 4d message 2 – message 8 (claimed “threaded messages”). The “thread-in” message is a part of the “threaded message”. Therefore, when the “threaded message” is accessed the “thread-in” messages are also accessed.

Kennedy failed to teach “indicating in a display separate from a message that said at least a portion of another message threaded in said message has been read when said message has been read”. However, Bailey et al teach on column 4 line 45-52, a display shows messages have been read and messages that have not been read. This display is separate from a message.

As Kennedy teaches “a portion of another message threaded in said message has been read when said message has been read” and Bailey et al teach “display of read and unread messages”, it would have been obvious to one skilled at the time the invention was made to modify Kennedy such that the modified system of Kennedy in view of Bailey et al would be able to support the system users not only accessing thread and threaded messages together but also a display to show thread and threaded messages have been read.

5. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy.

Kennedy teaches on item 38 Fig. 3 “local message store” (claimed “memory”). Kennedy teaches on Fig. 4a and 4b messages are threaded with other one or more messages. Kennedy also teaches on column 3 line 47-50 the reply message (claimed “threaded message”; see line 4-5 page 8 of the specifications for definition of “thread messages” by Applicant) includes a message identifier for a root message (claimed “includes at least a portion of another message”). Kennedy further teaches on column 3 line 53-58 and Fig. 5 the root message (claimed “another message”) and reply message are grouped (to be a threaded message). Kennedy also teaches on item 36 Fig. 3 email program module (claimed “controller”; including item 37 Fig 3 message manager program module). Kennedy teaches on column 2 line 63-64 nested replies are presented (claimed “accessing”) sequentially. Kennedy teaches on Fig. 4d message 2 – message 8 (claimed “threaded messages”). The “thread-in” message is a part of the “threaded message”. Therefore, when the “threaded message” is accessed the “thread-in” messages are also accessed.

Kennedy teaches on Fig. 4c “message 2” (claimed “a message threaded within another message”). Kennedy failed to teach “controller being.....has been accessed”. However, “Official Notice” is taken that a message (including the original message and its threaded reply message) is indicated as has been accessed is old and well known to one skilled in the art. When the message is indicated “accessed” any message included in is inherently indicated “accessed”.

It would have been obvious to one skilled at the time the invention was made to modify Kennedy to have “controller being.....has been accessed” such that the modified system of

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Kennedy would be able to support indication of messages have been accessed to the system users.

6. Claims 3-7, 11-15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy as stated in claim 2 above, and in view of Hicks (US: 6304573).

Regarding claim 3-7, 11-15, 17, 19, Kennedy failed to teach the deleting and saving actions by the controller to the email and voice mail messages. However, Hicks teaches on Column 3 Line 49 the actions of deleting and saving on the email and voice mail messages (Column 3 Line 62). It would have been obvious to one skilled at the time the invention was made to modify Kennedy for including the deleting/saving actions to the email and voice mail messages such that the modified system of Kennedy would be able to support these well known deleting/saving features to the system users.

Regarding claims 18 and 20, Kennedy teach on column 8 line 4-11 the system provides phone support. Kennedy also teach on column 7 line 52-54 the connections include a LAN. Therefore, Kennedy's system comprises a telephony-over-LAN messaging system.

7. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy as stated in claim 1 above, in view of Bailey et al, and further in view of Lytle et al (US: 6549950). Kennedy in view of Bailey et al failed to teach "said controller.....another message". However, Lytle et al teach on Fig. 23 an email reply to an original email message. The email reply shown on Fig. 23 is the claimed "a message which is threaded within another message".

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When the original email sender opens this reply email the original mail sender is prompted with options as “Message”, “Options”, “Other”, and “Customer” on Fig. 23.

Response to Arguments

8. Applicant's arguments filed on 11/5/04 have been fully considered but they are not persuasive.

- i) Applicant argues, on page 7, regarding claims 1 and 9. New grounds rejections necessitated by the amendments have been stated above.
- ii) Applicant argues, on page 8, regarding claims 2 and 10. The Examiner agrees Kennedy failed to teach “controller being.....has been accessed” and that is the reason why “Official Notice” is taken. As the Examiner stated in the rejection, a message (including the original message and its threaded reply message) is indicated as has been accessed is old and well known to one skilled in the art. When the message is indicated “accessed” any message included in is inherently indicated “accessed”. Applicant argues “Applicant disagrees.....is so ubiquitous as to justify Official Notice”. However, Applicant failed to specifically point out the supposed errors. Per MPEP 2144.03 [C], Applicant must specifically point out the supposed errors in the Examiner’s action,

which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communication from the examiner should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The

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examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any inquiry of a general nature or relating to the status of this application or proceeding should be mailed to:

Commissioner of Patents and Trademarks

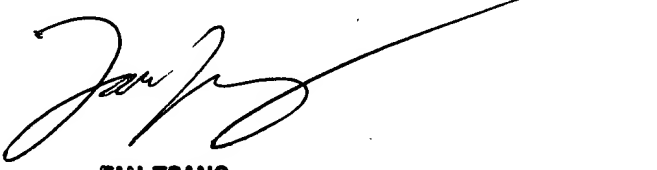
Washington, D.C. 20231

Or faxed to Central FAX Number 703-872-9306.

Patent Examiner

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Ming Chow



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600